

REMARKS/ARGUMENTS

Claims 1-2, 4, 8-13 and 15 remain in this application. Claims 3, 5-7 and 14 have been cancelled, and Claim 1 has been amended by this Amendment, as further discussed below.

Response to Restriction Requirement and Nonelection of Claims 6-7 and 14

Claims 1-5, 8-13 and 15 were previously elected for prosecution in this application, pursuant to a restriction requirement. Applicants hereby reserve the right to prosecute the subject matter of nonelected Claims 6-7 and 14 in a divisional patent application.

Claim Objections

Claim 5 has been objected to as being of improper dependent form in view of Claim 1. Accordingly, Claim 5 has been cancelled.

The Examiner has also indicated that he believes Claim 4 has a typographical error, because Claim 4 requires that the third solution comprises nitric acid. However, it is respectfully submitted that Claim 4 does not contain a typographical error. As set forth at paragraph [0019] of the specification as filed, in one embodiment the third solution may contain the solutions ALODINE 1200 and nitric acid. This is also disclosed in Table I at paragraph [00029], which sets forth that both the second solution (*i.e.*, solution 1-2) and the third solution (*i.e.*, solution 1-3) may contain nitric acid. Accordingly, it is respectfully submitted that Claim 4 does not contain a typographical error.

Rejection Under 35 U.S.C. 103

Claims 1-2 and 4-5 have been rejected as obvious in view of U.S. Patent No. 6,440,290 (Vega et al.) in combination with U.S. Patent No. 5,750,014 (Stadler et al.). However, Claim 3 has not been rejected in view of Vega et al. in combination with Stadler et al. Accordingly, the Examiner has acknowledged that Claim 3 is patentable over Vega et al. in combination with Stadler et al. In view of the foregoing, Claim 1 has been amended to incorporate the limitations of Claim 3, and Claim 3 has been cancelled. It is therefore respectfully submitted that Claim 1 (as well as Claims 2 and 4-5 dependent thereon) are nonobvious and patentable over the combination of Vega et al. and Stadler et al.

Claims 1-5, 8-13 and 15 have been rejected as obvious in view of U.S. Patent No. 5,486,283¹ (Mnich) in combination with Stadler et al. Mnich discloses a method for anodizing an aluminum workpiece using a two step process in which the workpiece is first anodized with a phosphoric acid solution, and then anodized with a mixture of sulfuric and boric acids. *See* col. 3, lines 40-50. Stadler et al. discloses an apparatus for selectively coating metal parts, in which a workpiece such as a piston head (12) is

¹ The Examiner erroneously cites Mnich (U.S. Patent No. 5,486,283) as U.S. Patent No. 6,440,290 at p. 5 of the Office Action.

secured within a plating tank (14), and the plating tank is interconnected to a number of storage tanks which contain, for example, cleaning solution (32), activating solution (34), electrolyte solution (36) and sealing solution (38). *See* Fig. 1 and col. 6, line 57, col. 7, line 44.

The Examiner's position is that Claims 1, 3, 8, 10, 13 and 15 are obvious in view of Mnich in combination with Stadler et al. because:

[I]t would have been obvious and within the ordinary skill in the art at the time the invention was made to have modified Mnich to use one process chamber and pumped multiple solutions into said chamber as taught by Stadler et al. because Stadler et al. teach that the substrate remains in one process chamber (Fig. 1, numeral 14) which would have minimized movement of the articles to be treated (cols. 4 and 5).

However, it is respectfully submitted that independent Claims 1, 8 and 15, as well as the remaining claims dependent thereon, are nonobvious and patentable over Mnich in combination with Stadler et al. Mnich specifically discloses that chromium is a known carcinogen, and that the amount of chromium waste that can be legally discharged into the air or water has been severely limited. *See* col. 1, lines 40-42. Accordingly, the method disclosed in Mnich is "chromium-free." *See* Mnich Claim 1. In contrast, as noted by the Examiner, Stadler et al. discloses at col. 7, lines 8-22 that sodium dichromate (which obviously contains chromium) may be employed as a solution. One of ordinary skill in the art would not be motivated to combine the teachings of the chromium-free method of Mnich with the teachings of Stadler et al. in view of the contemplated use of sodium dichromate in Stadler et al. Moreover, each of Claims 1, 8 and 15 in this application require the use of a sodium dichromate solution. Accordingly, Mnich actually teaches away from the subject matter of Stadler et al., as well as Claims 1, 8 and 15 of this application. In view of the foregoing, it is respectfully submitted that Claims 1-5, 8-13 and 15 are nonobvious and patentable over Mnich in combination with Stadler et al.

Conclusion

Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now present in the application are respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

Respectfully submitted for Applicant,



Louis S. Sorell, Esq. (Reg. No. 32,439)
GOODWIN PROCTER LLP
599 Lexington Avenue
New York, NY 10022
(212) 459-7421